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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.    | CONFIRMATION NO.     |
|--|-------------|----------------------|------------------------|----------------------|
| 09/663,661   | 09/15/2000  | Thomas S. Abbott     |                        | 2183                 |
| 7590   | 05/15/2006  |                      | EXAMINER<br>[REDACTED] | SAGER, MARK ALAN     |
| Michael E Mauney<br>Attorney at Law<br>PO 10266<br>Southport, NC 28461 |             |                      | ART UNIT<br>[REDACTED] | PAPER NUMBER<br>3712 |

DATE MAILED: 05/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |
|------------------------------|------------------------|---------------------|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |
|                              | 09/663,661             | ABBOTT, THOMAS S.   |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |
|                              | M. A. Sager            | 3712                |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 21 February 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-35 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-35 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____ .  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ .   | 6) <input type="checkbox"/> Other: _____ .                                  |

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The written specification, as originally filed, fails to support how to make/use the invention regarding invention as presently claimed for ‘with no predetermined delay’ at least due to an apparatus having mechanical reels mechanically stopped by a player using a braking device (as stated in Applicants specification, 10:16-11:19, especially 11:15-16) such as a stepper motor implicitly/inherently includes a delay for stepping down to stop the rotation of the mechanical reels. Additionally, the originally filed specification fails to support to ‘with no predetermined delay... of sufficient duration... entirely rotates off said means for display’, as claimed, at least since no citation within the specification teaches, or suggests and it is neither implicit nor inherent regarding ‘of sufficient duration... entirely rotates off said display’ (10:16-11:19, esp. 11:15-16). The mere fact that no delay is discussed is not evidence of claimed invention, as presently claimed, esp. in consideration of implicit/inherent delay for stopping using a stepper motor. Further, with respect to ‘means for displaying a portion of said reels to a player... full symbols may be visually perceived by said player’, the specification, as originally filed, does not support any method or means to determine what a player perceives.

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3. Claims 7-9 and 16-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear as to how symbols on a reel (virtual or mechanical) are constrained to stop outside of pre-determined location since symbols at locations on reels are fixed at start of game and thus some symbol must stop on the pre-determined location once the reels begin to spin (esp. in consideration of use of braking device for mechanical apparatus) even if the symbol is a blank, it is by definition a symbol. Thus, the language is confusing. Better phrasing may be possible by focusing on a play that expires does not count against player as a game play (18:9-24).

***Claim Rejections - 35 USC § 102***

4. Claims 1-2 and 10-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Nolte (6165070). This holding is maintained for cited claims, as amended, and reiterated below. Response to Applicants' remarks is provided below and incorporated herein. Nolte discloses a rotating reel based game apparatus requiring patience, skill, knowledge and concentration to play well (1:8-10, 2:15-24, 35-54, 3:47-4:4, 5:62-66, 16:2-23, figs. 1-12), comprising a plurality of reels (figs. 1-4), a plurality of predetermined fixed symbols with said symbols randomly distributed on each of said reels (5:62-6:63, M), means for displaying a portion of said reels to a player so that for each of said reels at least two or a plurality of full symbols of said symbols on each of said reels may be visually perceived by said player (3:47-4:3. 4:64-7:9, 16:2-23, figs. 1-4, refs. 28-38; at least due to 1.99% is visually equivalent to at least two full symbols in that visually, player perceives two full symbols, for instance, 0.99 of a displayed Z symbol would be perceived as a full Z symbol by a player in that the player mentally would perceive a full Z

symbol, for instance; although, programmatically, 0.99 Z symbol is displayed), means for rotating each of said reels (10:24-58, 16:24-19:15 , figs. 1-6), a player controlled stop for each of said reels so that under the control of a player said rotation of said reels may be stopped such as a player pressing key stop button 17 and one video frame image passes from stop button press until stop time (11:15-33, 12:45-13:49), a predetermined location within said portion of said reels that is displayed to said player (4:50-63, 12:1-34, 16:55-18:52, Play Combination Sequence Table), means for determining if a symbol of said two ( or a plurality of) full symbols visually perceived by said player of said plurality of fixed symbols on each of said reels is stopped within a predetermined location (9:1-12, 24-34, 16:2-18:59), a results table to determine the outcome of play of said game based on whether said player has timed the operation of stops whereby at least one of said predetermined fixed symbols is stopped within one of said predetermined locations (18:26-59), whereby said player plays said rotating reel based game by initiating means for rotating (start key 21) each of said reels then using said player controlled stops (stop key 17) for each of said reels to attempt to stop said symbol of said plurality (or at least two) full symbols within said predetermined location according to results table to maximize results for player (15:49-19:15, esp. 17:46-18:53, fig. 1-12) and including wherein said means for rotating each of said reels rotates said reels at a rotational speed so that said player has a time interval at least one-tenth of a second to use said player controlled stop to stop the rotation of the reels whereby the player may control if a symbol of said at least two (or a plurality of) full symbols visually perceived by said player of said plurality of fixed symbols is stopped within said predetermined locations (11:15-33, 13:1-15:26, 16:2-23) at least since a player using skill and memory of sequential order of the icons and of time delay for the stop of each grid of Nolte's game may use

the stop button 17 to stop the reels so that icons of winning combinations stop in locations selected (e.g. pay/win lines) and there is no temporal requirement of perceiving at least two (or a plurality of) full symbols at same instant. Essentially, a player of Nolte's game must memorize a longer string of the symbol sequence and also memorize delay of grid cells (16:2-23) such that by perceiving a starter symbol (i.e. icon E, or any other icon) of a memorized string of symbol sequence (E, AA, V, and Z or any other icon sequence of Partial Randomized Iconic Database Table) and with knowledge of time delay (1 to 4 video frames), a player of Nolte's game presses a stop button 17 so as to stop a desired symbol (i.e. Z or any other winning icon) of the symbol sequence in a desired location being a pay/win line.

Further, regarding 'with no predetermined delay, between... off said means for display', while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). In this case, Nolte discloses all claimed structure of game apparatus for a skill-based game with a player controlled stop for each of said reels so that under the control of a player rotation of the reels may be stopped where the player using skill and memory attempts to align

winning configuration of symbols on a win line (sic); whereas, the claimed invention is a game apparatus for a skill-based game having a player controlled stop with no delay so as to be purely visual reflex. The form of machine for claimed purpose or function is not patentably differentiated.

Also, a claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987) (The preamble of claim 1 recited that the apparatus was “for mixing flowing developer material” and the body of the claim recited “means for mixing ... , said mixing means being stationary and completely submerged in the developer material”. The claim was rejected over a reference which taught all the structural limitations of the claim for the intended use of mixing flowing developer. However, the mixer was only partially submerged in the developer material. The Board held that the amount of submersion is immaterial to the structure of the mixer and thus the claim was properly rejected.). In this case, Nolte discloses all claimed structure of game apparatus for a skill-based game with a player-controlled stop device (17) having a programmed delay in order to require player to use memory of a longer sequence of symbols in conjunction with timing (i.e. skill) to successfully stop winning configuration of symbols on win line; whereas, claimed invention is player controlled stop with no delay to be purely visual reflex with no memorization of sequence of symbols necessary. The form of machine for claimed purpose or function is not patentably differentiated.

***Claim Rejections - 35 USC § 103***

5. Claims 1-2, 10-11 and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nolte in view of either Leshik (4501422) or Ohki (3650535) or Kelly (5584763). Alternatively, Nolte discloses a game apparatus or method that lacks ‘with no predetermined delay, between … rotates off said means for display’. However, skill based games with no predetermined delay between activation of player controlled stop by a player and the stopping of symbols or indicators or rotation of reels is notoriously well known so as to require a visual reflex by player with no memorization of sequence of symbols being necessary. Leshik (3a, 3b) or Kelly (3:63-64) or Ohki (2:55-63) each disclose apparatus teaching no predetermined delay between activation of player controlled stop by a player and the stopping of symbols or indicators or rotating reels for purely visual reflex with no memorization of sequence of symbols necessary. Therefore, it would have been obvious to an artisan at a time prior to the invention to add with no predetermined delay, between … rotates off said means for display’ as notoriously well known as taught by either Leshik or Ohki or Kelly to Nolte’s apparatus or method so as to simplify construction of device by not requiring delay thereby reducing cost of manufacture and to simplify play of game by not requiring memorization of sequence of symbols.

6. Claims 3-9, 12-25, and 28-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nolte in view of Seibert (6174234) or, alternatively, over Nolte in view of either Leshik or Ohki or Kelly as applied to claims above, and further in view of Seibert (6174234). Nolte or Nolte in view of either Leshik or Ohki or Kelly discloses claimed game apparatus or method (supra) including a bonus (10:12-15) but lacks a bonus window.. prior to initiating said means for rotating each of said symbols… results thereby, as particularly claimed. However, Seibert

discloses a player activated game apparatus (abstract, 7:57-8:47) teaching a bonus window.. prior to initiating said means for rotating each of said symbols... results thereby, as particularly claimed, so as to notify player of bonus symbol prior to play for bonus award for increased player strategy. Therefore, it would have been obvious to an artisan at a time prior to the invention to add a bonus window.. prior to initiating said means for rotating each of said symbols... results thereby, as particularly claimed, as taught by Seibert to Nolte's apparatus and method or Nolte's apparatus and method in view of either Leshik or Ohki or Kelly so as to notify player of bonus symbol prior to play for bonus award for increased player strategy.

***Response to Arguments***

7. Applicant's arguments filed Feb 21, 2006 have been fully considered but they are not persuasive. Regarding Applicants' remark that Nolte fails to teach two full symbols, the examiner respectfully disagrees. It is noted that the claim language includes 'may be visually perceived by said player' and as such a player viewing rotating symbols may perceive two full symbols for Nolte's programmed 1.99 symbols. In reply to Applicants' opine that the examiner re-writes Applicants' claims to make Nolte a 102 reference, the examiner disagrees. The Examiner has noted breadth of claim language with broadest reasonable interpretation thereto and applied art (i.e. Nolte) in accordance with patent law.

Regarding apparatus claims, while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus

because the limitations at issue were found to be inherent in the prior art reference); see also *In re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). “[A]pparatus claims cover what a device is, not what a device does.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). In this case, Nolte discloses all claimed structure of game apparatus for a skill-based game with a player controlled stop for each of said reels so that under the control of a player rotation of the reels may be stopped where the player using skill and memory attempts to align winning configuration of symbols on a win line (sic); whereas, the claimed invention is a game apparatus for a skill-based game having a player controlled stop with no delay so as to be purely visual reflex. The form of machine for claimed purpose or function is not patentably differentiated.

Also, a claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987) (The preamble of claim 1 recited that the apparatus was “for mixing flowing developer material” and the body of the claim recited “means for mixing ..., said mixing means being stationary and completely submerged in the developer material”. The claim was rejected over a reference that taught all the structural limitations of the claim for the intended use of mixing flowing developer. However, the mixer was only partially submerged in the developer material. The Board held that the amount of submersion is immaterial to the structure of the mixer and thus the claim was properly rejected.). In this case, Nolte discloses all claimed structure of game apparatus for a skill-based game with a

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player-controlled stop device (17) having a programmed delay in order to require player to use memory of a sequence of symbols in conjunction with timing (i.e. skill) to successfully stop winning configuration of symbols on win line; whereas, claimed invention is player controlled stop with no delay to be purely visual reflex with no memorization of sequence of symbols necessary. The form of machine for claimed purpose or function is not patentably differentiated.

8. Applicant's arguments with respect to claims 1-35 have been considered but are moot in view of the new ground(s) of rejection.

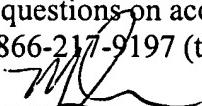
***Conclusion***

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. A. Sager whose telephone number is 571-272-4454. The examiner can normally be reached on T-F, 0700-1730 hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, John Hotaling can be reached on 571-272-4437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



M.A. Sager  
Primary Examiner  
Art Unit 3712

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